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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,125	08/07/2001	Didier Communi	9409/2092	3058

27495 7590 05/19/2004

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EXAMINER

LI, RUIXIANG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/924,125

**Applicant(s)**

COMMUNI ET AL.

**Examiner**

Ruixiang Li

**Art Unit**

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 46-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46, 47, 50, and 51 is/are allowed.
- 6) ☒ Claim(s) 48, 49 and 52-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Status of Application**

The Request filed on February 23, 2004 for Continued Examination (RCE) under 37 CFR 1.114 of Application 09/924,125 is granted. An action on the RCE follows.

### **Applicants' Amendment and Claims**

Applicants' amendment filed on February 23, 2004 has been entered in full. Claims 1-45 have been canceled. Claims 46-60 have been added. Claims 40-60 are pending and under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

### **Withdrawn Rejections and/or Objections**

Applicants' cancellation of claims 1-36 has made all the rejections and objections as set forth in the final action (December 2, 2003) moot. However, since the rejections of cancelled claims might be applicable to the new claims, the issues related to the rejections of cancelled claims in the record are clarified below.

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The rejections of claims 7-14, 23, 24, and 26-28 under 35 U.S.C. § 101 and under 35 U. S. C. § 112, 1<sup>st</sup> paragraph for enablement due to lack of utility, as set forth in the previous office actions (Paper No. 14 & 19), have been withdrawn in view of the Dr. Jean-Marie Boeynaems's Rule 132 Declaration submitted by Applicants, which substantiates the functional activity of the GPR86, an ADP receptor, in the immune process.

The rejection of claims 7-14, 23, 24, and 26-28 under 35 U. S. C. § 112, 2<sup>nd</sup> paragraph, as set forth in the previous office actions (Paper No. 14 & 19), have been withdrawn in view of the recitation of SEQ ID NO: 2 in the new claims.

#### **Claim Rejections Under 35 U. S. C. § 112, 2<sup>nd</sup> Paragraph**

Claims 48, 49, 52-60 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 48 and 59 recite in the method step (c) "at least 10% of the amount induced by said ADP". It is not clear how the effect of a candidate modulator or an agent on the signaling of GPR86 is compared with ADP; for example, it is unclear which concentrations are used for the comparison. Thus, it is not clear what the metes and bounds of the term are, rendering the claims indefinite. Claims 52-60 are rejected as dependent claims from claim 48 or 49.

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### **Conclusion**

Claims 46, 47, 50, and 51 are allowed.

### **Suggestions**

Claims 46 and 47 recite, in step (b), "measuring binding of said GPR86 polypeptide to said ADP", which could be amended in a better form in accordance with the art as "measuring binding of said ADP to said GPR86 polypeptide".

### **Advisory Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (571) 272-0875. The examiner can normally be reached on Monday-Friday, 8:30 am-5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (571) 272-0871. The fax number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the

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Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Ruixiang Li, Ph.D.  
Examiner  
May 5, 2004

*Mary L. Kunz*  
MARY KUNZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600